

REMARKS

Claims 2, 21, and 38 stand rejected based on 35 U.S.C. Sect. 112, second paragraph. Claims 2, 21, and 38 have been cancelled without prejudice or disclaimer. These claims have been cancelled to narrow the scope of the numerous issues raised by the Examiner in the Office Action. Applicants reserve the right to add the claimed subject matter to this application or a continuing application at a later date.

Claims 1-3, 6-22, 25-40, and 43-54 stand rejected based on 35 U.S.C. Sect. 102(b) as being anticipated by USP 5,638,443 (Stefik). This rejection is traversed based on the arguments set forth below.

The Examiner indicates that Stefik teaches dynamically assigning rights based on dynamic conditions. However, Stefik teaches that conditions can be part of a usage right and that the manner of use within the right can be different based on the conditions. For example, at col. 18, lines 9-26, Stefik discloses that a right has a transactional component 1451 that corresponds to a manner of use, and a specifications component 1452 that corresponds to conditions. The usage rights disclosed in Stefik, including a manner of use and conditions for example, are attached, i.e. assigned, to content. See Fig. 1 step 102 and col. 6, lines 16-49. Conditions of the assigned rights can then be considered after assignment of the rights. In contrast, the claims recite that the usage rights are *assigned* based on dynamic conditions.

In the claimed invention, the usage rights are actually assigned to content based on dynamic conditions occurring before, or at the time of association of the rights with content. This permits simple and efficient rights to be assigned to content while permitting the rights to be set based on the status of a dynamic condition at the time of, or before, setting the

rights. For these reasons, the invention, as recited in the amended claims is novel over the prior art.

The Examiner takes the position that the “means for” language in the claims does not invoke interpretation under 35 U.S.C. Sect. 112, 6th paragraph. However, this position is unsupported and is not consistent with established case law and Patent Office Practice.

MPEP 2181 provides that:

- A claim limitation will be >presumed< to invoke 35 U.S.C. **112**, sixth paragraph, if it meets the following 3-prong analysis:
- (A) the claim limitations must use the phrase "means for" or "step for;"
 - (B) the "means for" or "step for" must be modified by functional language; and
 - (C) the phrase "means for" or "step for" must not be modified by sufficient structure, material>,< or acts for achieving the specified function.

The means limitations of claims 18-54 meet all three criteria set forth above and the Examiner has not provided any basis for determining otherwise. Accordingly, the elements of claims 18-54 which begin with the phrase “means for” should be construed in accordance with 35 U.S.C. Sect. 112, 6th paragraph. Since the Examiner’s determination that 112, 6th paragraph does not apply was contrary to case the law and Patent Office practice, the Examiner had opportunity to set forth any objections or rejections based on 35 U.S.C. Sect. 112, 1st and 2nd paragraphs, related to application of 112, 6th paragraph. The Examiner has failed to set forth any such objection/rejection. MPEP 706 states:

The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicants have the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.

Further, the Examiner’s determination that claimed functions have “been given little patentable weight” is directly contradictory to 35 U.S.C. Sect. 112, 6th paragraph and must be

withdrawn. The stated purpose of 112, 6th paragraph is to permit Applicants to claim element in terms of their function.

With respect to claims 1-17, which do not recite any “means for” or “step for” elements, Applicants note that 112, 6th paragraph does not apply to these claims. MPEP 2181 states:

Thus, absent an express recitation of "means for" or "step for" in the limitation, the broadest reasonable interpretation will not be limited to "corresponding structure...and equivalents thereof." *Morris*, 127 F.3d at 1055, 44 USPQ2d at 1028 ("no comparable mandate in the patent statute that relates the claim scope of non-§ 112 paragraph 6 claims to particular matter found in the specification").

The Examiner requests the Applicants either elect to be their “own lexicographer” or waive any right to do so. However, this too is contrary to established law and Patent Office practice. MPEP 2111 sets forth that:

The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 CFR **1.75(d)(1)**.

In other words, patent claims are to be construed in the context of the disclosure, without the need for Applicants to make the choice presented by the Examiner. The Examiner presents definitions for the terms “server”, “client”, “computer”, “internet”, “for”, “dynamic”, and “resolution”. Applicants note that the terms “server”, “client”, “computer”, and “internet” are not recited in the claims. In footnote 8 on page 25 of the Office Action, the Examiner notes that he is trying to interpret the “concepts found in the definitions themselves

or in the prior art.” However, no facts have been established on the record that such definitions are necessary for interpreting the claims. To the extent that definitions are required to interpret the prior art, the Examiner should indicate on the record which terms of the prior art are being applied to the claims and how those terms are being interpreted to provide applicants opportunity to rebut any *prima facie* positions set forth by the Examiner.

Also, Applicants note that the definitions set forth for “dynamic” and “resolution” clearly are not consistent with the specification and thus cannot be adopted for purposes of prosecution. With respect to “dynamic”, the Examiner proposes a definition that is limited to “programming, processing, memory, or the like.” Clearly, the term “dynamic” as discussed in the specification, and the related applications incorporated therein, can be external of, and not related to, programming, processing, memory, or the like. With respect to “resolution”, the Examiner proposes “the representation of a vector in terms of its components”. Again, this is entirely inconsistent with the specification. The resolution recited in the claims clearly is “image resolution”. See Paragraph 26 of the subject application. As examples, a search on www.google.com yields the following definitions for “image resolution”.

- The number of pixels in a digital photo is commonly referred to as its image resolution.
www.bytecamera.com/content/view/23/27/
- The fineness or coarseness of an image as it was digitized, measured as dots-per-inch (DPI).
www.rockprint.com/dictionary.shtml
- The number of pixels displayed per unit of printed length in an image, usually measured in pixels per inch (ppi) or dots per inch (dpi). In Photoshop, you can change the resolution of an image.
www.zakros.com/mica/emacs01/glossary1.html
- The amount of information stored in each image that is measured by pixels per inch (ppi) or dot per inch (dpi). Internet Explorer - A web browser created by Microsoft.
www.fws.gov/video/glossary.htm

- The amount of data stored in a image file, measured in pixels per inch (dpi).
www.vistek.ca/glossary/default.asp
- A measurement of the quality of a video image based on the number of pixels that make up the image.
www.digitalpostproduction.com/Htm/Features/DigitalVideoGlossary.htm
- for pictures or imager data, indicates the number of pixels per unit of length; often measured in dpi (dots per inch); said to be 'higher' resolution as dpi increases, showing more image detail
mynasadata.larc.nasa.gov/glossary.html
- This relates to the number of pixels per unit length of image. Eg pixels per inch, pixels per millimetre, or pixels wide etc..
www.all-things-photography.com/digital-dictionary.html
- It is measured in ppi ie pixel per inch. It can be defined as number of pixels in the image. The more the pixel in the image the higher is the resolution and larger is the size of the file. It can be explained with the following example. A 1-inch square of an image scanned at 72 ppi contains 5184 pixels (72 X 72) and has a file size of 6K, if the same file is scanned at 144 ppi will contain 20736 pixels (144 X 144) will have file size 21 K.
www.insidegraphics.com/articles/image_printer_resolution.asp
- The number of satellite scan lines represented in each data point of an image line. Resolution can be increased or decreased; see blow up and blow down. Also see full resolution and satellite resolution.
www.ssec.wisc.edu/mcidas/doc/prog_man/2003/glossary.html
- The number of pixels or dots per inch (dpi) specified when the image was created. In most cases, this number is relevant only for displaying or printing the image.
www.csbsju.edu/itservices/teaching/graphics/default.htm
- The number of pixels in the horizontal and vertical directions.
www.uni-duesseldorf.de/URZ/hardware/parallel/local/xsi/XSI.html/files/docs/html/glossary/glossary.htm

- depends on the amount of area that is represented by each individual pixel in an image; the smaller the area, the more accurate and thus detailed the image.
www.tsgc.utexas.edu/stars/glossary1.html
- The number of pixels per unit area in an image. Should be expressed as ppi (pixels per inch) and not dpi (dots per inch) which refers to output resolution.
www.psincorp.com/howto_glossary.htm
- image resolution measures the number of pixel per inch (2.54 cm). This resolution is mainly linked with the resolution of the scanner.
lib.ua.ac.be/MAN/T04/t25.html
- The image resolution is a term that says something about how much image detail an image can hold. The term is most often used in relation to digital images, but is also used to describe how grainy a "film-based" image is. Higher resolution means more image detail. ...
en.wikipedia.org/wiki/Image_resolution

Applicants are not asserting any one of the definitions above as the proper definitions. The definitions are presented to demonstrate the term “resolution”, as used in the claims, does not relate to vectors. Accordingly, the Examiner should adopt definitions that are consistent with the specification of the subject application. Clearly the asserted definitions for “resolution” and “dynamic” are inconsistent with the specification and do not appear to serve the Examiner’s stated objective of forwarding prosecution and interpreting the claim as broadly as is reasonably possible.

Further, Applicants note that the proffered definition of Server includes software, but the proffered definition of Client does not. Finally, the Examiner’s attempt at interpreting the word “for” is entirely inappropriate. Clearly, this word should be given its ordinary meaning to the extent it is not part of a special statutory clause, such as a means-plus-function clause.

For the reasons above, all of the pending claims are in condition for allowance and such allowance is solicited. However, if the Examiner deems that any issue remains after considering this response, the Examiner is invited to contact the undersigned attorney to expedite the prosecution and engage in a joint effort to work out a mutually satisfactory solution.

Respectfully submitted,

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